

## **REMARKS**

This paper is prepared in response to the final Office action mailed 20 September 2007 (Paper No. 20070904).

### **I. Amendment of the Specification**

The fourth paragraph in column 5 is amended to insert the inadvertently omitted noun "edge" in the phrase "and rear edge123 ... ."

Paper No. 20070904 newly raises an objection to one paragraph of the specification. The specification is amended to overcome the objection to the specification set forth on page 3 of the Office action. Specifically, at line 52 in column 5, the phrase "a pair of wide passage" is amended to read --a pair of wide passages--. Accordingly, withdrawal of the objection to the specification is respectfully requested.

The same paragraph is also amended to correct the syntax of the introductory phrases (i) [However, the cross] Cross rail 130 is however," and (ii) "~~The wide~~ Wide passages 135a, 135b."

### **II. Listing of the Claims**

Pursuant to 37 CFR §1.121(c), this listing of the claims, including the text of the claims, will serve to replace all prior versions of the claims, in the application.

### **III. Amendment of the Claims**

No amendments are made to any of the pending claims by this paper.

### **IV. Status of the Claims**

Claims 21 through 60 are pending in the application. Claims 1 through 20 were previously canceled.

### **V. Rejection of Claims 21-51 Under Second Paragraph Of 35 U.S.C. §112**

Reissue claims 21 through 51 are rejected under the second paragraph of 35 U.S.C. §112,

as being possibly indefinite. Applicant respectfully traverses this rejection for the following reasons.

In support of this rejection, Paper No. 20070904 states that:

“With regard to amended claim 21, the phrase “at least one of said not more than two separate air bearing platforms including a sidewall contiguous with one of said boundaries” is vague and ambiguous with respect to the Applicant’s disclosure and invention as described within the specification and drawings.

More concretely, as set forth in the language of claim 1, at lines 3-8, the slider is recited to have:

‘a body with a principal surface disposed to confront a recording surface of a recording medium, said principal surface having a Lead portion and a rear portion, said lead portion being, spaced upstream from said rear portion relative to a rotational direction of any recording medium confronted by said slider, said lead portion having a front edge, said rear portion having a rear edge, said *front edge* and said *rear edge together defining boundaries* of said principal surface *in a longitudinal direction of said slider body*;’

Emphasis added. The Applicant has now amended claim 21 to require that “at least one of said not more than two separate air bearing platforms including a *sidewall contiguous with one of said boundaries*” (emphasis added) is misdescriptive of the invention as disclosed. None of the two separate air bearing platforms (e.g., 110c, 110d) are contiguous with the “boundaries” as previously defined within the claim.

That is, the “boundaries” of the principal surface are defined by “said *front edge* [e.g., 121] and said *rear edge* [e.g., 123] *together . . . in a longitudinal direction of said slider body*,” See claim 21, lines 7-8. Emphasis added.

That is, this is consistent with the longitudinal extent of the distance between the rear and the front edge of the slider along the longitudinal axis L as exemplified in Applicant’s Figure 4.

Stated another way, the front edge (e.g., 121) defines one boundary; the rear edge (e.g., 123) defines another boundary. The

front and rear edges (121, 123) together, define boundaries of the principal surface (e.g., 111) in a longitudinal direction (along L as seen, e.g., in FIG. 4) of the slider body (100).

More specifically, none of the two separate air bearing platforms (e.g., 110c, 110d) are contiguous with either the front edge (121) or the rear edge (123) of the slider body, as depicted and/or described in the Applicant's originally filed disclosure.

Thus, claim 21, as amended by Applicant in the Response filed August 22, 2007, is misdescriptive, ambiguous and indefinite as to the true meaning and scope when viewed in light of the Applicant's original disclosure.

Additionally, since claims 22-30 depend directly or indirectly from claim 21, they too are thus rejected under the second paragraph of 35 U.S.C. §112.

Similarly, with regard to claim 31, the Applicant defines "boundaries" as "said front edge and said rear edge together defining longitudinal boundaries of said principal surface in said first direction." See claim 31, lines 5-6.

Amended claim 31, then recites, "at least one of said not more than two separate air bearing platforms extending from an edge of one of said boundaries." *Id.* at lines 12-13.

None of the two separate air bearing platforms (e.g., 110c, 110d) extend from an edge of one of the boundaries (at 121 and/or 123) as depicted and/or described in the Applicant's originally filed disclosure.

Additionally, since claims 32-41 depend directly or indirectly from claim 31, they too are thus rejected under the second paragraph of 35 U.S.C. §112.

Also, with regard to claim 42, the Applicant defines "boundaries" as "said front edge and said rear edge together defining boundaries of said principal surface in said longitudinal direction of said slider." See claim 42, lines 8-9.

Amended claim 42, then recites, "at least one of said not more than two separate air bearing platforms extending from an edge of one of said boundaries." *Id.* at lines 17-18.

Again, as is factually evident, none of the two separate air bearing platforms (e.g., 110c, 110d) extend from an edge of one of the boundaries (at 121 and/or 123) as depicted and/or described in the Applicant's originally filed disclosure.

Additionally, since claims 43-51 depend directly or indirectly from claim 42, they too are thus rejected under the

second paragraph of 35 U.S.C. §112.”<sup>1</sup>

Applicant submits that the foregoing analysis kindly elaborated by the Examiner is partially correct, and partially in error.

**First**, Paper No. 20070904 inaccurately introduces errors into the text of Applicant’s claims 21 through 51 by relying upon such paraphrases as, by way of example:

“the front edge (e.g., 121) defines one boundary; the rear edge (e.g., 123) defines another boundary. The front and rear edges (121, 123) together, define boundaries of the principal surface (e.g., 111) in a longitudinal direction (along L as seen, e.g., in FIG. 4) of the slider body (100).”<sup>2</sup>

None of Applicant’s claims define a structure in which “the front edge (e.g., 121) defines one boundary.” None of Applicant’s claims define a structure in which “the rear edge (e.g., 123) defines another boundary.” Instead, claims 21 through 51 define structures in which “[t]he front and rear edges (121, 123) **together**, define boundaries of the principal surface (e.g., 111) in a longitudinal direction (along L as seen, e.g., in FIG. 4) of the slider body (100).” Each feature of each of claims 21 through 51 must be given meaning, and that meaning must be consistent with the entirety of the subject matter sought to be patented by the Applicant. To the extent therefore, that this rejection is premised upon the Examiner’s factual finding that Applicant’s claims define a structure in which “the front edge (e.g., 121) defines one boundary” or upon a factual finding that Applicant’s claims define a structure in which “the rear edge (e.g., 123) defines another boundary”, the conclusion of indefiniteness is unsustainable.

Moreover, the Examiner’s factual finding is geometrically inconsistent with the Examiner’s subsequent assertion about the structure of Murray ‘432’s Figures 4 and 5, that:

“the longitudinal edges are the most outboard side edges, or sidewalls *of rails* (14e, 14d) of the slider in a longitudinal

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<sup>1</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, pages 7-10.

<sup>2</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 5.

directions have an extent no greater than the front and rear edges along the longitudinal direction, as is clearly evident from FIGS. 4 and 5).”<sup>3</sup>

This assertion about the structure of Murray ‘432 demonstrates that the rationale given by the Examining staff in support of this rejection is specious. Withdrawal of this rejection is therefore respectfully solicited.

**Second**, and contrary to the foregoing analysis, none of Applicant’s claims define a structure where,

“the front edge (e.g., 121) defines one boundary; the rear edge (e.g., 123) defines another boundary.”<sup>4</sup>

Instead, these claims define a structure where,

“The front and rear edges (121, 123) **together**, define boundaries of the principal surface (e.g., 111) **in a longitudinal direction** (along L as seen, e.g., in FIG. 4) of the slider body (100).”<sup>5</sup>

Or, in the words of Paper No. 20070904,

“That is, the “boundaries” of the principal surface are defined by “said *front edge* [e.g., 121] and said *rear edge* [e.g., 123] **together . . . in a longitudinal direction of said slider body**,” See claim 21, lines 7-8.”<sup>6</sup> Emphasis in original.

These statements are geometrically inconsistent with such other statements written in Paper No. 20070904, as:

“More specifically, none of the two separate air bearing platforms (e.g., 110c, 110d) are contiguous with either the front edge (121) or the rear edge (123) of the slider body, as depicted and/or

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<sup>3</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 12.

<sup>4</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 5.

<sup>5</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 5.

<sup>6</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 5.

described in the Applicant's originally filed disclosure",<sup>7</sup>

because, as is correctly observed in Paper No. 20070904, the "boundaries" are "in a longitudinal direction of said slider body." Moreover, "said *front edge* [e.g., 121] and said *rear edge* [e.g., 123]" are transverse to the "longitudinal direction of said slider body ...".<sup>8</sup>

Consequently, and as is defined by claims 21 through 51 inclusive, "[t]he front **and** rear edges (121, 123) **together**, define boundaries of the principal surface (e.g., 111) **in a longitudinal direction** (along L as seen, e.g., in FIG. 4) of the slider body (100)"<sup>9</sup> and, as defined by Claim 21, "at least one of said not more than two separate air bearing platforms including a sidewall [is] contiguous with one of said boundaries"; or as defined by Claim 31, "said front edge and said rear edge together defining longitudinal boundaries of said principal surface in said first direction"; or, as defined by Claim 42, "said front edge and said rear edge together defining boundaries of said principal surface in said longitudinal direction of said slider".

In view of these consistencies, and the conformance of the foregoing text of Claims 21, 31 and 42 with Applicant's original specification, withdrawal of this rejection is respectfully urged.

#### **VI. Rejection of Claims 21-51 Under First Paragraph Of 35 U.S.C. §112**

Claims 21 through 51 are rejected under the first paragraph of 35 U.S.C. §112 based upon the Examiner's inquiry of whether claims 21 through 51 fail "to comply with the written description requirement."<sup>10</sup> There is no averment in Paper No. 20070904 that Applicant's originally filed specification fails to provide enablement to one of ordinary skill in the art.

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<sup>7</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 5.

<sup>8</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 5.

<sup>9</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 5.

<sup>10</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 7.

Applicant respectfully traverses this rejection for the following reasons.

In support of this rejection, Paper No. 20070904 stated that:

“The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With regard to amended claim 21, the phrase “at least one of said not more than two separate air bearing platforms including a sidewall contiguous with one of said boundaries” was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

More concretely, as set forth in the language of claim 1, at lines 3-8, the slider is recited to have:

a body with a principal surface disposed to confront a recording surface of a recording medium, said principal surface having a lead portion and a rear portion, said lead portion being, spaced upstream from said rear portion relative to a rotational direction of any recording medium confronted by said slider, said lead portion having a front edge, said rear portion having a rear edge, said *front edge* and said *rear edge together defining boundaries* of said principal surface *in a longitudinal direction of said slider body*; and Emphasis added.

The Applicant has now amended claim 21 to require that “at least one of said not more than two separate air bearing platforms including a *sidewall contiguous with one of said boundaries*” (emphasis added).

As originally disclosed, however, none of the two separate air bearing platforms (e.g., 110c, 110d) are contiguous with the “boundaries” as previously defined within the claim. That is, the “boundaries” of the principal surface are defined by “said *front edge* [e.g., 121] and said *rear edge* [e.g., 123] *together . . . in a longitudinal direction of said slider body*.” See claim 21, lines 7-8. Emphasis added.

That is, the language is consistent with the longitudinal extent of the distance between the rear and the front edge of the slider along the longitudinal axis L as exemplified in Applicant’s

Figure 4.

Stated another way, the front edge (e.g., 121) defines one boundary; the rear edge (e.g., 123) defines another boundary.

The front and rear edges (121, 123) together, define boundaries of the principal surface (e.g., 111) in a longitudinal direction (along L as seen, e.g., in FIG. 4) of said slider body (100).

More specifically, the invention as originally filed, fails to disclose any of the two separate air bearing platforms (e.g., 110c, 110d) as being contiguous with either the front edge (121) or the rear edge (123) of the slider body, as depicted and/or described in the Applicant's originally filed disclosure.

Thus, claim 21, as amended by Applicant in the Response filed August 22, 2007, contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Additionally, since claims 22-30 depend directly or indirectly from claim 21, they too are thus rejected under the first paragraph of 35 U.S.C. § 112.

Similarly, with regard to claim 31, the Applicant defines "boundaries" as "said front edge and said rear edge together defining longitudinal boundaries of said principal surface in said first direction." See claim 31, lines 5-6. Amended claim 31, then recites, "at least one of said not more than two separate air bearing platforms extending from an edge of one of said boundaries." *Id.* at lines 12-13.

None of the two separate air-bearing platforms (e.g., 110c, 110d) extend from an edge of one of the boundaries (at 121 and/or 123) as depicted and/or described in the Applicant's originally filed disclosure.

Additionally, since claims 32-41 depend directly or indirectly from claim 31, they too are thus rejected under the first paragraph of 35 U.S.C. § 112.

Also, with regard to claim 42, the Applicant defines "boundaries" as "said front edge and said rear edge together defining boundaries of said principal surface in said longitudinal direction of said slider." See claim 42, lines 8-9.

Amended claim 42, then recites, "at least one of said not more than two separate air bearing platforms extending from an



edge of one of said boundaries.” *Id.* at lines 17-18.

Again, as is factually evident, none of the two separate air bearing platforms (e.g., 110c, 110d) extend from an edge of one of the boundaries (at 121 and/or 123) as depicted and/or described in the Applicant’s originally filed disclosure.”<sup>11</sup>

The conclusion that claims 21 through 51 may fail to comply with the written description requirement is not supported by either the evidence of record in the prosecution history of this application or by the Examiner’s foregoing analysis of that evidence. Applicant submits that some of the statements given in the Examiner’s analysis are technically accurate and some of the conclusions drawn in the Examiner’s analysis are erroneous.

**First**, the Examiner’s ultimate conclusion of a lack of a written description is erroneous, and is unsupported by the evidence of record in this prosecution history. The Examiner’s conclusion that each of Applicant’s claims 21 through 51,

“contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention”,<sup>12</sup>

is not supported by the Examiner’s threshold finding of fact that:

“the invention as originally filed, fails to disclose any of the two separate air bearing platforms (e.g., 110c, 110d) as being contiguous with either the front edge (121) or the rear edge (123) of the slider body, as depicted and/or described in the Applicant’s originally filed disclosure”,<sup>13</sup>

and is inconsistent with the Examiner’s finding of fact that:

“[t]he front and rear edges (121, 123) together, define boundaries of the principal surface (e.g., 111) in a longitudinal direction

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<sup>11</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, pages 7-10.

<sup>12</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 8.

<sup>13</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 8.

(along L as seen, e.g., in FIG. 4) of said slider body (100).”<sup>14</sup>

More particularly, independent claim 21 reads “[t]he front and rear edges (121, 123) **together**, define boundaries of the principal surface (e.g., 111) in a longitudinal direction (along L as seen, e.g., in FIG. 4) of the slider body (100)”;<sup>15</sup> while, “with regard to claim 31, the Applicant defines ‘boundaries’ as ‘said front edge and said rear edge together defining longitudinal boundaries of said principal surface in said first direction.’ See claim 31, lines 5-6”;<sup>16</sup> and “with regard to claim 42, the Applicant defines ‘boundaries’ as ‘said front edge and said rear edge together defining boundaries of said principal surface in said longitudinal direction of said slider.’ See claim 42, lines 8-9.”<sup>17</sup> In short, the Examiner’s threshold finding of fact that:

“the invention as originally filed, fails to disclose any of the two separate air bearing platforms (e.g., 110c, 110d) as being contiguous with either the front edge (121) or the rear edge (123) of the slider body, as depicted and/or described in the Applicant’s originally filed disclosure”,<sup>18</sup>

is unrepresentative of the actual text of Applicant’s claims, is grossly inaccurate, and wholly inconsistent with the foregoing interpretations of claims 21, 31 and 42 made of record by the Examiner in Paper No. 20070904 because, among other reasons none of these claims defines a structure where “any of the two separate air bearing platforms (e.g., 110c, 110d) as being contiguous with either the front edge (121) or the rear edge (123)”<sup>19</sup> while such components of Applicant’s original specification as, for example, Figure 4, illustrate a sidewall 190 that is

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<sup>14</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 8.

<sup>15</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 5. Emphasis in original.

<sup>16</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 5.

<sup>17</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 6.

<sup>18</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 8.

<sup>19</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 8.

contiguous with side edge 192 of slider body 100 extending between lead edge 121 and rear edge 123. This written description provided by the drawings fully supports the questioned language of claims 21 through 51.

Moreover, the Examiner's factual finding is geometrically inconsistent with the Examiner's subsequent assertion about the structure of Murray '432's Figures 4 and 5, that:

“the longitudinal edges are the most outboard side edges, or sidewalls *of rails* (14e, 14d) of the slider in a longitudinal directions have an extent no greater that the front and rear edges along the longitudinal direction, as is clearly evident from FIGS. 4 and 5).”<sup>20</sup>

This assertion about the structure of Murray '432 demonstrates that the rationale given by the Examining staff in support of this rejection is specious. Withdrawal of this rejection is therefore proper.

**Second**, under current Office practice, the test for sufficiency of support by original application for the written disclosure is,

“whether the disclosure of the application relied upon *reasonably conveys to the artisan that the inventor had possession at the time of the later claimed subject matter.*”<sup>21</sup>

Where, as here, Applicant's original specification details such features, as, for example, for example, Figure 4 which illustrates a sidewall 190 that is contiguous with side edge 192 of slider body 100 extending between lead edge 121 and rear edge 123, Applicant conforms to the rule that “possession may be shown in a variety of ways including ... such as the disclosure of drawings.”<sup>22</sup> Accordingly, Applicant's original application demonstrates that Applicant was in

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<sup>20</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 12.

<sup>21</sup> §2163.02 – Standard for Determining Compliance With The Written Description Requirement, *Manual of Patent Examining Procedure*, 8<sup>th</sup> Ed., Rev. 6, page 21—186 (Sept. 2007).

<sup>22</sup> §2163.02 – Standard for Determining Compliance With The Written Description Requirement, *Manual of Patent Examining Procedure*, 8<sup>th</sup> Ed., Rev. 6, page 21—186

possession of the inventions claimed by claims 21 through 51 “*at the time of the later claimed subject matter.*”<sup>23</sup> This rejection may not therefore, be sustained.

**Third**, the ultimate conclusion of a lack of written description is improperly based upon a substitution of a faulty paraphrase for the actual language of Applicant’s claims. By way of example, none of Applicant’s claims 21 through 51 read:

“any of the two separate air bearing platforms (e.g., 110c, 110d) as being contiguous with either the front edge (121) or the rear edge (123) of the slider body ... .”<sup>24</sup>

Instead, Applicant’s claim 21 reads, “at least one of said not more than two separate air bearing platforms including a sidewall contiguous with one of said boundaries”; claim 31 reads, “at least one of said not more than two separate air bearing platforms extending from an edge of one of said boundaries”; and claim 42 reads, “at least one of said not more than two separate air bearing platforms extending from an edge of one of said boundaries ... .” To the extent therefore, that this rejection is premised upon the Examiner’s factual finding that Applicant’s claims define a structure in which “any of the two separate air bearing platforms (e.g., 110c, 110d) as being contiguous with either the front edge (121) or the rear edge (123) of the slider body ... .”<sup>25</sup>, the conclusion of indefiniteness is unsustainable. Withdrawal of this rejection is therefore respectfully solicited.

**Fourth**, the Examiner’s conclusion of a lack of a written description is based upon the Examiner’s erroneous conclusion that Applicant’s claims define, among features,

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(Sept. 2007).

<sup>23</sup> §2163.02 – Standard for Determining Compliance With The Written Description Requirement, *Manual of Patent Examining Procedure*, 8<sup>th</sup> Ed., Rev. 6, page 21—186 (Sept. 2007).

<sup>24</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 8.

<sup>25</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 8.

“any of the two separate air bearing platforms (e.g., 110c, 110d) as being contiguous with either the front edge (121) or the rear edge (123) of the slider body, as depicted and/or described in the Applicant’s originally filed disclosure ... .”<sup>26</sup>

In point of fact, none of claims 21, 31 or 42 define structures in which “any of the two separate air bearing platforms (e.g., 110c, 110d) [are] contiguous with either the front edge (121) or the rear edge (123) of the slider body.” Accordingly, there is no basis for sustaining this rejection.

### **VII. Rejection of Claims 52-60 Under 35 U.S.C. §102(b)**

**Reissue claims 52-60 are rejected under 35 U.S.C. §102(b) as being anticipated by Murray, U.S. Patent No. 5,406,432.** Applicant respectfully traverses this rejection for the following reasons.

In support of this rejection, Paper No. 20070904 states that:

“As per claims 52, 55 and 58, Murray (US 5,406,432) discloses a negative pressure air bearing slider (11) having a negative pressure cavity (e.g., between the rails 14e, 14d of FIG. 4 and 5 - note the corresponding designations of 14e, 14d are not expressly shown in FIG. 5), comprising: a body with a principal surface (flat, non-raised surface of slider (11) facing a recording medium, the outer lateral extent of which is the side of rails (14e, 14d) - this is indeed a principal surface) disposed to confront a recording surface of a recording medium, said principal surface having a lead portion (proximate (11a)) separated from a rear portion (proximate pad (14a)) by a central portion (portion of slider between the aforementioned lead and rear portions), said lead portion and said central portion being spaced upstream from said rear portion relative to a rotational direction of any recording medium

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<sup>26</sup> In full, the excerpted sentence from the Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 8, states, “More specifically, the invention as originally filed, fails to disclose **any of the two separate air bearing platforms (e.g., 110c, 110d) as being contiguous with either the front edge (121) or the rear edge (123) of the slider body**, as depicted and/or described in the Applicant’s originally filed disclosure.” Emphasis added.

confronted by said slider (11) (i.e., the rotational direction of a recording medium would be in a tangential direction of right-to-left as seen in FIGS. 4 and 5), said lead portion having a front edge (at (11a)), said rear portion having a rear edge (11b), said front edge (11a) and said rear edge (11b) together defining boundaries of longitudinal edges (or sides) of said principal surface in a longitudinal direction of said slider body (11) (i.e., the most outboard side edges, or sidewalls of rails (14e, 14d) of the slider *in a longitudinal direction* have a longitudinal extent no greater than the front and rear edges along the longitudinal direction, as is clearly evident from FIGS. 4 and 5), said central portion being formed by opposite longitudinal sides separated by a longitudinal center and bounded by said longitudinal edges (e.g., see FIGS. 4 and 5); and a plurality of arcuately shaped arms (14e and 14d) embracing a majority of said principal surface and each having distal ends extending from opposite ones of said longitudinal sides (i.e., the aforementioned most outboard sidewalls of rails (14e, 14d)) curving or arcuately inwardly across said central portion of said principal surface with spaced-apart proximal facing ends (e.g., the inboard most facing side edges or sidewalls of rails (14e, 14d) that directly face each other) of said arms together forming a U-shaped air bearing platform located between said boundaries to separate a negative pressure cavity defined by said arms (14e, 14d) on said principal surface from said boundaries (i.e., the most outboard side edges, or sidewalls of rails (14e, 14d) of the slider in a longitudinal direction have a longitudinal extent no greater than the front and rear edges along the longitudinal direction, as is clearly evident from FIGS. 4 and 5); at least one of said distal ends (of rails (14e, 14d)) forming a terminal end wholly within said central portion and spaced-apart from said rear portion (that is, both rails (14e, 14) terminate prior to the trailing edge (11b)).

As per claims 53, 56 and 59, further comprising a cross-rail portion (e.g., including 14b) of said platform extending generally laterally across said principal surface and connecting said proximal facing ends (e.g., the inboard most facing side edges or sidewalls of rails (14e, 14d) that directly face each other).

As per claims 54, 57 and 60, further comprising said arms (14e, 14d) adjoining said longitudinal edges - again, the longitudinal edges are the most outboard side edges, or sidewalls *of rails* (14e, 14d) of the slider in a longitudinal directions have an

extent no greater than the front and rear edges along the longitudinal direction, as is clearly evident from FIGS. 4 and 5).

Absolutely nothing in the invention as presently drafted limits the “longitudinal edges (or sides)” to the outermost edges of the sidewall(s) of the slider body.

Note furthermore that even Applicant’s own description of the invention, makes it abundantly clear, that the side edge of the slider body is not necessarily parallel or contiguous with a sidewall of the slider body. For instance, as Applicant recites in the amendment to the specification (e.g., see page 2 of Applicant’s amendment filed August 22, 2007):

‘The U-shaped air-bearing platform circumscribes a majority of negative pressure cavity 150 that is formed on principal surface 111. At least one of the rear ABS platforms 110c, 110d includes a sidewall 190 that is contiguous with side edge 192 of slider body 100 extending between lead edge 121 and rear 123 . . . [Emphasis added - see Applicant’s amended FIG. 4, also filed on August 22, 2007.1.]’”

This analysis of claims 52 through 60 is not supported by the record of the prosecution history.

**First**, the foregoing analysis of claims 52, 55 and 58 is inaccurate. None of Applicant’s pending claims read,

“a plurality of arcuately shaped arms (14e and 14d) embracing a majority of said principal surface and each having distal ends extending from opposite ones of said longitudinal sides (i.e., the aforementioned most outboard sidewalls of rails (14e, 14d)) curving or arcuately inwardly across said central portion of said principal surface with spaced-apart proximal facing ends (e.g., the inboard most facing side edges or sidewalls of rails (14e, 14d) that directly face each other) of said arms together forming a U-shaped air bearing platform located between said boundaries to separate a negative pressure cavity defined by said arms (14e, 14d) on said principal surface from said boundaries (i.e., the most outboard side edges, or sidewalls of rails (14e, 14d) of the slider in a longitudinal direction have a longitudinal extent no greater than the front and rear edges along the longitudinal direction, as is clearly evident from FIGs. 4 and 5).”

The foregoing analysis however, inaccurately characterizes Murray ‘432’s teaching of these, and

other, features. In point of fact, claim 52 states:

“spaced-apart proximal facing ends of said arms together forming a U-shaped air bearing platform located between said boundaries to separate a negative pressure cavity defined by said arms on said principal surface from said boundaries, at least one of said arms extending from an edge of one of said boundaries ... .”

Claim 55 states:

“a plurality of arcuately shaped arms embracing a majority of said principal surface and each having distal ends extending from opposite ones of said longitudinal sides arcuately inwardly across said principal surface with spaced-apart proximal facing ends of said arms together forming a U-shaped air bearing platform ... .”

Claim 58 states:

“a plurality of arcuately shaped arms each having distal ends extending from opposite ones of said longitudinal sides curving inwardly across said central portion of said principal surface with spaced-apart proximal facing ends of said arms together forming a U-shaped air bearing platform ... .”

The foregoing Examiner's analysis makes only pretense that these features of claims 52, 55 and 58 are found in the prior art represented by Murray '432, and this pretense is unable to reliably demonstrate a suggestion of the features of Applicant's claims 52 through 60 by Murray '432. The mere fact that Paper No. 20070904 states that Murray '432 “discloses” certain features of Applicant's claims does not transform the actual disclosure by Murray '432 so as to erase all differences between Murray '432's actual teachings and Applicant's claims.

**Firstly**, Paper No. 20070904 avers that Murray '432 “discloses ... a plurality of arcuately shaped arms (14e and 14d) ... each having distal ends *extending from* opposite ones of said longitudinal sides (i.e., the aforementioned most outboard sidewalls of rails (14e, 14d)).” Murray '432 shows in Figures 4 and 5, segment 14b with fork leg 14d, 14e of center rail 14



*spaced-apart from* the longitudinal sides which stretch between leading edge 11a and trailing edge 11b. In making the excerpted statement, it appears to be the intention of the Examiner to also assert that under 35 U.S.C. §102(b), the phrase *extending from* is synonymous to and fully interchangeable with *spaced-apart from*. Paper No. 20070904 fails to explain this critical link in the Examiner's analysis of Murray '432. Written clarification pursuant to 37 CFR §1.104(a) and (b) is respectfully requested.

Does the Examiner mean to further assert that under 35 U.S.C. §102(b), there is no difference between Applicant's phrase *extending from* and the apt description of Murray '432's center rail 14 as *spaced-apart from*? Paper No. 20070904 fails to explain this critical link in the Examiner's analysis of Murray '432. Written clarification pursuant to 37 CFR §1.104(a) and (b) is respectfully requested.

Applicant notes that as an aside, that the foregoing analysis by the Examining staff is equally applicable to such other references of record as, by way of example, U.S. Patent No. 5,568,981 to Nepala *et al.*

Additionally, Applicant submits that in the crowded field of air bearing magnetic head sliders, Class 360, Murray '432 inferentially explains that the area subtended by his wishbone is minimized because the "broadening"<sup>27</sup> of the leading center rail 14 into a wishbone shape "creates a large area within the wishbone in which a vacuum will form. The degree of vacuum is velocity dependent based on disk RPM and track radius *so that the slider loading increases with application speed*"<sup>28</sup> and reducing "the vacuum"<sup>29</sup> ... has an **advantage** for attitude control *because vacuum adds loading ...*"<sup>30</sup> Consequently, there is no basis suggested by Murray '432 to increase the "large area within the wishbone in which a vacuum will form."

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<sup>27</sup> Murray U.S. 5,406,532, column 4, line 4.

<sup>28</sup> Murray U.S. 5,406,532, column 4, lines 6-9.

<sup>29</sup> Murray U.S. 5,406,532, column 4, line 21.

<sup>30</sup> Murray U.S. 5,406,532, column 4, line 25 and 26.

**Secondly**, Paper No. 20070904 avers that Murray ‘432 “discloses ... a plurality of arcuately shaped arms (14e and 14d) embracing a majority of said principal surface ... .” In actuality, Murray ‘432 shows in Figures 4 and 5, segment 14b with fork leg 14d, 14e of center rail 14 *occupying* what could arguably be labeled as something close to a majority of said principal surface”, but the portion of the principal surface *embraced* by center rail 14 is visually less than the portion of the principal surface *occupied* by center rail of Murray ‘432, and thus less than Applicant’s “majority of said principal surface.” In making the excerpted statement, does the Examiner mean to also assert that under 35 U.S.C. §102(b), the phrase *embracing a majority* of said principal surface is synonymous to and fully interchangeable with a structure that, at best, embraces a *minority* of the principal surface? Paper No. 20070904 fails to explain this critical link in the Examiner’s analysis of Murray ‘432. Written clarification pursuant to 37 CFR §1.104(a) and (b) is respectfully requested.

As mentioned in the **MPEP §2131**, “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Every element must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (CAFC 1989). The **identical** invention must be shown in as complete detail as is contained in the patent claim. *Id.*, “**All words** in a claim **must be considered** in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970), and MPEP 2143.03.<sup>31</sup>

**Second**, Paper No. 20070904, in essence, inaccurately asserts that that under 35 U.S.C. §102(b), Applicant’s:

“a plurality of arcuately shaped arms each having distal ends  
extending from opposite ones of said longitudinal sides curving

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<sup>31</sup> *Manual of Patent Examining Procedure*, 8<sup>th</sup> Edition, Rev. 6 (Sept. 2007), citing *Verdegaal Brothers v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987.)

inwardly across said central portion of said principal surface with spaced-apart proximal facing ends of said arms together forming a U-shaped air bearing platform located between said boundaries to separate a negative pressure cavity defined by said arms on said principal surface from said boundaries, at least one of said arms **extending from an edge of one of said boundaries**”,

is the same as Murray ‘432’s:

plurality of arcuately shaped arms each having distal ends **spaced-apart** from opposite ones of said longitudinal sides curving inwardly across said central portion of said principal surface with spaced-apart proximal facing ends of said arms together forming a U-shaped air bearing platform located between said boundaries to separate a negative pressure cavity defined by said arms on said principal surface from said boundaries, **both** of said arms **spaced-apart** from an edge of one of said boundaries” ... .”

**Third**, Paper No. 20070904 erroneously asserts that that under 35 U.S.C. §102(b), Applicant’s:

“a plurality of arcuately shaped arms **embracing a majority of** said principal surface and each having distal ends **extending from** opposite ones of said longitudinal sides arcuately inwardly across said principal surface with spaced-apart proximal facing ends of said arms together forming a U-shaped air bearing platform located between said boundaries to separate a negative pressure cavity defined by said arms on said principal surface from said boundaries”,

is the same as Murray ‘432’s:

plurality of arcuately shaped arms embracing a **minority** of said principal surface and each having distal ends **spaced-apart** from opposite ones of said longitudinal sides arcuately inwardly across said principal surface with spaced-apart proximal facing ends of said arms together forming a U-shaped air bearing platform located between said boundaries to separate a negative pressure cavity defined by said arms on said principal surface from said boundaries ... .”

Fourth, Paper No. 20070904, in essence, improperly asserts that that under 35 U.S.C. §102(b), Applicant’s:

“a plurality of arcuately shaped arms each having distal ends **extending from** opposite ones of said longitudinal sides curving inwardly across said central portion of said principal surface with spaced-apart proximal facing ends of said arms together forming a U-shaped air bearing platform located between said boundaries to separate a negative pressure cavity defined by said arms on said principal surface from said boundaries, at least one of said arms **extending from** an edge of one of said boundaries”?

is the same as Murray ‘432’s:

“plurality of arcuately shaped arms each having distal ends **spaced-apart** from opposite ones of said longitudinal sides curving inwardly across said central portion of said principal surface with spaced-apart proximal facing ends of said arms together forming a U-shaped air bearing platform located between said boundaries to separate a negative pressure cavity defined by said arms on said principal surface from said boundaries, at least

both of said arms spaced-apart from an edge of one of said boundaries ... .”

Paper No. 20070904 fails to explain this critical link in the Examiner’s analysis of Murray ‘432. Written clarification pursuant to 37 CFR §1.104(a) and (b) is respectfully requested.

Applicants’ independent claims 52, 55 and 58 define relations between the boundaries defined by the front edge and the rear edge, and the air bearing platforms. These relations are absent from Murray ‘432. Accordingly, there is no anticipation.

Applicant observes that the Examining staff’s assertion that:

“The Examiner, as clearly articulated in the rejection, *supra*, has set forth a one-to-one correspondence with each and every element of the claimed invention. More concretely, as recited MPEP1\$2 106:

Office personnel are to give claims their ***broadest reasonable interpretation*** in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). ***Limitations appearing in the specification but not recited in the claim are not read into the claim.*** *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. . . . The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed. . . . An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”). [Emphasis in bold italics added].”

is mere Examiner argument, and unhelpful in advancing the prosecution of this application. Where, as here, there are structural differences between each of claims 52, 55 and 58, and those of Figures 4 and 5 of Murray ‘432, and where the Examining staff either utterly ignores or is otherwise unable to identify such articulated structural differences as Applicant’s:

“a plurality of arcuately shaped arms embracing a majority of

said principal surface and each having distal ends extending from opposite ones of said longitudinal sides arcuately inwardly across said principal surface with spaced-apart proximal facing ends of said arms together forming a U-shaped air bearing platform located between said boundaries to separate a negative pressure cavity defined by said arms on said principal surface from said boundaries”,

in the such exemplars of the art Murray ‘432’s, the Examining staff has failed to make a *prima facie* showing of anticipation with the degree of completeness required by MPEP §2131 with a demonstration by the Examining staff in which “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Every element must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (CAFC 1989). The **identical** invention must be shown in as complete detail as is contained in the patent claim. Id., “**All words** in a claim **must be considered** in judging the patentability of that claim against the prior art.” *In re. Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970), and MPEP 2143.03,<sup>32</sup> there is no anticipation. Accordingly, withdrawal of this rejection is respectfully urged.

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<sup>32</sup> *Manual of Patent Examining Procedure*, 8<sup>th</sup> Edition, Rev. 6 (Sept. 2007), citing *Verdegaal Brothers v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987.)

### **VIII. Conclusion**

The final Office action set forth in Paper No. 20070904 raise three separate grounds of rejection. These are:

#### **Indefiniteness Under The Second Paragraph Of 35 U.S.C. §112**

As admitted by the Examining staff in Paper No. 20070904, Applicant's claims 21 through 51 define a structure where,

“The front and rear edges (121, 123) **together**, define boundaries of the principal surface (e.g., 111) **in a longitudinal direction** (along L as seen, e.g., in FIG. 4) of the slider body (100).”<sup>33</sup>

This statement is geometrically inconsistent with such other statements written in Paper No. 20070904, as:

“More specifically, none of the two separate air bearing platforms (e.g., 110c, 110d) are contiguous with either the front edge (121) or the rear edge (123) of the slider body, as depicted and/or described in the Applicant's originally filed disclosure”,<sup>34</sup>

because, as is correctly observed in Paper No. 20070904, the “boundaries” are “in a longitudinal direction of said slider body.” Or, in the words of Paper No. 20070904,

“That is, the “boundaries” of the principal surface are defined by “said *front edge* [e.g., 121] and said *rear edge* [e.g., 123] **together ... in a longitudinal direction of said slider body**,” See claim 21, lines 7-8.”<sup>35</sup> Emphasis in original.

Moreover, “said *front edge* [e.g., 121] and said *rear edge* [e.g., 123]” are transverse to the “**longitudinal direction of said slider body ...**”<sup>36</sup>

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<sup>33</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 5.

<sup>34</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 5.

<sup>35</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 5.

<sup>36</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 5.

Consequently, and as is defined by claims 21 through 51 inclusive, “[t]he front **and** rear edges (121, 123) **together**, define boundaries of the principal surface (e.g., 111) **in a longitudinal direction** (along L as seen, e.g., in FIG. 4) of the slider body (100)”<sup>37</sup> and, as defined by Claim 21, “at least one of said not more than two separate air bearing platforms including a sidewall [is] contiguous with one of said boundaries”; or as defined by Claim 31, “said front edge and said rear edge together defining longitudinal boundaries of said principal surface in said first direction”; or, as defined by Claim 42, “said front edge and said rear edge together defining boundaries of said principal surface in said longitudinal direction of said slider”.

In view of these consistencies, and the conformance of the foregoing text of Claims 21, 31 and 42 with Applicant’s original specification, withdrawal of this rejection is respectfully urged.

#### **Written Description Under The First Paragraph Of 35 U.S.C. §112**

None of claims 21, 31 or 42 define structures in which “any of the two separate air bearing platforms (e.g., 110c, 110d) [are] contiguous with either the front edge (121) or the rear edge (123) of the slider body.” Accordingly, there is no basis for sustaining this rejection. This paraphrase concocted by the Examining staff is unrepresentative of the actual text of Applicant’s claims, is grossly inaccurate, and wholly inconsistent with the foregoing interpretations of claims 21, 31 and 42 made of record by the Examiner in Paper No. 20070904 because, among other reasons none of these claims defines a structure where “any of the two separate air bearing platforms (e.g., 110c, 110d) as being contiguous with either the front edge (121) or the rear edge (123)”<sup>38</sup> while such components of Applicant’s original specification as, for example, Figure 4, illustrate a sidewall 190 that is contiguous with side edge 192 of slider body 100 extending between lead edge 121 and rear edge 123. This written description provided by the drawings

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<sup>37</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 5.

<sup>38</sup> Office action mailed 20<sup>th</sup> September 2007, Paper No. 20070904, page 8.



fully supports the questioned language of claims 21 through 51.

**35 U.S.C. §102(b)**

The mere fact that Paper No. 20070904 states that Murray '432 "discloses" certain features of Applicant's claims does not transform the actual disclosure by Murray '432 so as to erase all differences between Murray '432's actual teachings and Applicant's claims. The naked assertion by Paper No. 20070904 that Murray '432 "discloses" in Figures 4 and 5 the structure defined by Applicant's claims 52 through 60, "arcuately shaped arms (14e and 14d) embracing a **majority** of said principal surface ..." is an existential clintonian contradiction that wrongly blurs, or removes, all distinctions between the adjective "majority" and the adjectives "plurality" and "minority" that is unsupported by the record of the prosecution history before the Board.

The Examining staff has cited no evidence of record to justify its deliberate failure to ignore the different evidentiary inferences between 1 distinctions between the adjective "majority" and the adjectives "plurality" and "minority."

Moreover, the Examining staff has failed to heed the mandate imposed by the *Manual* that "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."<sup>39</sup>

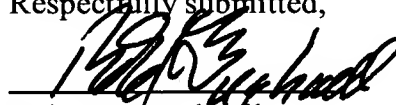
In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' undersigned attorney.

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<sup>39</sup> *Manual of Patent Examining Procedure*, 8<sup>th</sup> Edition, Rev. 6 (Sept. 2007), citing *Verdegaal Brothers v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987.)

No fees are believed to be incurred by this Amendment. Should other fees be incurred however, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicants' undersigned attorney in the amount of such fees after concurrently notifying Applicants' undersigned attorney.

Respectfully submitted,



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